

Application No.: 10/038642

Case No.: 56995US002

## REMARKS

Claims 1 to 22 and 46-48 are pending. Claims 23 to 45 have been canceled.

### §102 Rejection of Claims 1-11 and 46-48

Claims 1 - 11 and 46-48 stand rejected under 35 USC § 102(b) as being anticipated by Gajewski et al. (U.S. Patent No. 5,208,080). The Office Action states:

Gajewski et al. discloses a laminate (col. 1, lines 13-14) comprising a first and second bonding sheets (col. 8, lines 3-4) made from polyvinyl butyral that have a major surface surfaces and peripheral edges (col. 7, lines 1-2 and Figure 2, #12 and 24), wherein both the first and second bonding layers are suitable for bonding to glazing components (col. 5, lines 21-24 and lines 29-32). A transparent optical sheet comprising an extruded multi-layer sheet of semi-rigid material having a major surface and a peripheral edge (col. 7, lines 15-16 and Fig. 4, #26) such as polyester (col. 8, lines 26-27) is located in between the laminating sheets and glazing components (col. 5, lines 21-32) and is bonded with the bonding sheets by laying the edge of the optical sheet within the peripheral edge of the bonding sheet (Fig. 2). As seen in Fig. 4, the major surface of the optical sheet and the major surface of the bonding materials are positioned together. The optical film is of size so that it is positioned within the peripheral edge of the glazing components (Figs. 1 and 2, Column 6, 8, lines 35-37). While one of the major surfaces of the bonding sheets are in contact with the optical sheet, the other major surface of the bonding sheets are in contact with the major surfaces of the glazing components (Figure 2, #12, 14, 24 and 22). The optical film is completely within the peripheral edges of the glazing components (Figure 2, #12, 20 and 22). The layers in the laminate are fully bonded together so that no voids adjacent to the peripheral edge of the optical sheet (Fig. 5). (Emphasis Added)

### Applicant's Response

The Office Action description of the embodiment in Fig. 4 (col. 7, lines 13-31) is not correct. Gajewski et al. expressly state: "... a single interlayer 16' may be comprised of an extruded multilayer sheet 26 of semi-rigid sheet material 20 sandwiched between and chemically linked to layers 14 and 24 of thermoplastic laminating materials." (see col. 7, lines 15-18). Gajewski et al. go on to state: "The laminate thus formed encapsulates the semi-rigid sheet 20 in thermoplastic material and achieves a safety laminate of similar high optical quality as enjoyed with the preferred embodiment." (col. 7, lines 28-31). In addition, the single layer of semi-rigid material (20) is expressly disclosed as being used to provide additional strength to the laminate assembly (10). (see col. 7, lines 54-55). Based on their own description, the multilayer sheet (26)

Application No.: 10/038642

Case No.: 56995US002

is clearly described as a co-extruded laminate of the layer of thermoplastic material (14), the single layer of the semi-rigid material, e.g., polyester (20) and another layer of thermoplastic material (24). Fig. 4 and the corresponding description do not disclose, teach or even suggest the use of "a non-metallic multi-layer optical film", as that term is expressly described and claimed in the present application. Therefore, the Office Action does not present a prima facie case of anticipation against claims 1-11 and 46-48. Accordingly, because Gajewski et al. do not disclose each and every element recited in any of the rejected claims, the rejection of claims 1-11 and 46-48 under 35 USC § 102(b) as being anticipated by Gajewski et al. (U.S. Patent No. 5,208,080) has been overcome and should be withdrawn.

### **§103 Rejection of Claims 12-22**

Claims 12-22 stand rejected under 35 USC § 103(a) as being unpatentable over Gajewski et al. in view of Frost et al. (U.S. Patent No. 6,352,754). The Office Action states:

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the slits and the different sizes of optical sheets in Gajewski et al. in order to remove excess material from the intermediate film to ensure that the film is completely encased by the outer substrates, controlling corrosive risks and for inserting wires and other electronic equipment in between the layers of material.

### **Applicant's Response**

As discussed above, Gajewski et al. do not disclose each and every element recited in any of the rejected claims. Therefore, even if the person of ordinary skill in the art was motivated to combine Gajewski et al. and Frost et al., as indicated in the Office Action, the invention of claims 12-22 would not result. Therefore, the Office Action does not present a prima facie case of obviousness against claims 12-22. Accordingly, this § 103(a) rejection of claims 12-22 has been overcome and should be withdrawn.

It is also submitted that there are other limitations recited in the claims, in addition to those discussed above, which further distinguish the claimed invention patentably from the cited art and the other art of record. These additional distinguishing limitations will not be discussed

Application No.: 10/038642

Case No.: S6995US002

because there is no need to do so at this time. Accordingly, it is submitted that the §102 and §103 rejections should be withdrawn and the case allowed.

**CONCLUSION**

In view of the above, it is submitted that the application is in condition for allowance.

Reconsideration of the application is requested.

Allowance of claims 1-22 and 46-48 at an early date is solicited.

Respectfully submitted,

6/18/04  
Date

By: Harold C. Knecht III  
Harold C. Knecht III, Reg. No.: 35,576  
Telephone No.: (651) 575-1056

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833